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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,526	04/27/2001	Robert Woolley Brunson	4750-000002	3732

27572 7590 09/11/2002

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. BOX 828  
BLOOMFIELD HILLS, MI 48303

EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
1742	4

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

Responsive to communication(s) filed on 6/18/02.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

Claim(s) 2 - 24 is/are pending in the application.

Of the above claim(s) 9 - 24 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 2 - 8  is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other \_\_\_\_\_

**Office Action Summary**

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election of Group I, claims 1-8, in Paper No. 3, filed June 19, 2002 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. This application contains claims 9-24 are drawn to an invention nonelected with traverse in Paper No. 3, filed on June 19, 2002. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Claim Rejections - 35 USC § 103*

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c ) and potential 35

U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-8 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5447035 to Workman et al.

6. The Workman reference(s) disclose(s) the features including the claimed cryogenic method steps of treating brake components. The features relied upon described above can be found in the reference(s) at: col. 3, line 15 to col. 4, line 15. The difference between the reference(s) and the claims are as follows: with respect to claims 2-3, Workman does not disclose to repeatedly heating to 300°F and cooling to room temperature. But a two step combination and two obvious process steps is unpatentable when each lends properties to the final product known to be produced when the step is practiced alone, in the absence of evidence of coaction between the steps which produce an obvious result. In re Fortress (CCPA 1966) 369 F2d 1009, 152 USPQ 13.

7. With respect to the limitation as in claim 4, the claimed "approximately 100 °F" reads on an ambient temperature.

8. With respect to the limitation as in claim 5 which reads on the teachings in Figure 2 and paragraph bridging col. 3 and 4 of said reference which teach raises the temperature from -300°F to an ambient temperature at about 15.5°F/hour. Because claimed temperature (approximately -100°F) is within temperature range set forth

above and because the temperature ramp up rate (15.5°F/hour) disclosed by Workman is slow enough to consider the brake component is tempered at approximately -100°F.

9. With respect to the limitations as set forth in claims 6-7 that it is insignificant where or what device to be used for heat treatment as long as the heating rates are same.

10. With respect to claim 8 that using inert gas in heat treatment chamber to protect heat treating material from oxidize is contemplated within ambit of ordinary skill artisan.

#### *Response to Arguments*

11. Applicant's arguments filed June 19, 2002 have been fully considered but they are not persuasive.

12. Applicant's argument as set forth in pages 6 and 7 of the instant remarks is noted. But, as set forth in the rejection above that applicant is required to show the repeated steps would produce unexpected result as set forth in *In re Fortress* (CCPA 1966) 369 F2d 1009, 152 USPQ 13, 13 below:

"Process claims are refused since process is an obvious combination of two processing steps, each lending to end

products the desirable properties each is known to produce when practiced alone, there being no evidence of a coaction between steps that produces unexpected results; one of ordinary skill in the art, having references before him, would perceive benefits of combination, without recourse to applicants' specification; no other combination of references can be made."

*Conclusion*

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

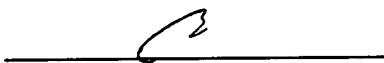
*Examiner Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
September 8, 2002